

### **REMARKS**

By this Amendment, Applicants amend claims 1 and 7 for purposes of clarity and add new claims 8-10. Support for new claims 8-10 is found in the specification at least at pages 7 and 8. Claims 1-10 are now pending in this application.

In the Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as obvious over Jovicic (U.S. Patent No. 5,855,007). The rejection of claims 1-7 under 35 U.S.C. § 103(a) is respectfully traversed for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation to modify the reference in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

Claim 1 recites a “method for providing electronic coupons” including, among other things, “selecting . . . at least one electronic coupon based on the determined profile of the user.” Jovicic does not disclose or suggest at least these features.

By contrast, in the Jovicic system, a person selects an electronic coupon 300 from an Internet Coupon Server 124. See col. 7, lines 46-48. According to Jovicic, to do so, a user browses through available coupons and makes a selection of a coupon 300. See col. 8, lines 1-2. In other words, in the Jovicic system, it is the user that must select the coupon. These teachings, however, do not disclose or suggest at least “selecting . . . at least one electronic coupon based on the determined profile of the

user,” as recited in claim 1. Instead, Jovicic requires a user to select a coupon by browsing through available coupons. Accordingly, Jovicic does not disclose or suggest all of the features of claim 1 for at least this reason.

The Examiner even admits that Jovicic “lacks an explicit recitation of ‘determining, at the processor, a profile of the user based on the information identifying the user; selecting, at the processor, at least one electronic coupon based on the determined profile of the user.’” See Office Action, page 3. However, the Examiner alleges that Jovicic at Figs. 1, 3, 4, and 6 implicitly shows these features. Applicants respectfully disagree.

Fig. 1 of Jovicic shows a communications system and its elements. Fig. 3 shows a exemplary message coupon format. However, Figs. 1 and 3 do not disclose or suggest a manner of selecting an electronic coupon. Fig. 4 merely includes step 412, labeled “user select coupon from browsing memory.” In other words, Fig. 4 indicates that a user must select a coupon, as discussed above. Although Fig. 6 shows an operational sequence of a user registration process that includes a step 608 of “user input demographic data,” Fig. 6, however, does not show a process for selecting coupons.

Moreover, Jovicic instead discloses that information describing a consumer is used to assess the value of a coupon distributing effort and to modify future marketing plans, i.e., after the coupon has been selected by the user and redeemed. See col. 2, lines 28-36. Accordingly, Jovicic does not disclose or suggest “selecting . . . at least one electronic coupon based on the determined profile of the user,” as recited in claim 1.

Even if the Examiner were correct in the characterizations of Jovicic made in the Office Action, which Applicants disagree with for the above reasons, the Examiner has not established a motivation for modifying Jovicic to arrive at Applicants' claimed invention. Instead, the Examiner alleges a motivation to modify Jovicic so that "a consumer significantly decreases the amount of time and effort expended in locating, clipping, and assembling coupons." See Office Action, page 4. However, this alleged motivation does not suggest to one of ordinary skill in the art any reason to modify Jovicic to arrive at Applicants' claimed invention.

With regard to the Examiner's allegation, Applicants respectfully point out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120. Instead, the statement cited by the Examiner teaches away from Applicants' claimed invention because Jovicic requires a user to select a coupon.

Furthermore, the statement cited by the Examiner merely indicates that an electronic coupon generating system saves a consumer time. It does not, however, suggest any reasons to modify Jovicic to arrive at Applicants' claimed combination recited in claim 1, including at least "selecting . . . at least one electronic coupon based on the determined profile of the user." Accordingly, it appears that the Examiner is impermissibly relying upon features of Applicants' claimed invention to the exclusion of what Jovicic suggests to one of ordinary skill in the art. By contrast, the required

motivation to combine references must “be found in the prior art, and not based on applicant’s disclosure.” See M.P.E.P. § 2143 (emphasis added). Nor has the Examiner offered any reasonable expectation of success for making the Examiner’s proposed modifications of Jovicic.

For at least these reasons, claim 1 is allowable over Jovicic. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a) and allow the claim.

Claims 2-5 depend upon allowable claim 1. As explained above, claim 1 is allowable over Jovicic. Accordingly, claims 2-5 are allowable over Jovicic at least by reason of their dependence from allowable claim 1.

Additionally, in alleging that Jovicic implicitly shows the recitations of dependent claims 2-5, the Examiner has not addressed any of the individual recitations of claims 2-5. See Office Action, page 4. The rejection is improper for at least this reason, because the Examiner is obligated to show how the prior art teaches or suggests *all claim elements* of Applicants’ invention. See M.P.E.P. §§ 706.02(j), 2143.03. Moreover, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. The Examiner has provided no explanation of how Jovicic supposedly teaches or suggests each and every recitation of claims 2-5. In fact, the Examiner failed to even mention any of the recitations of claims 2-5. By not addressing individual claim recitations, the Examiner has failed to meet the burden of establishing that *all claim recitations* are taught or suggested by the cited reference. See M.P.E.P. § 2143.03.

Applicants further traverse the Examiner's taking of Official Notice found on page 4 of the Office Action with regard to claims 2-5. Applicants refer the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice." In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (Memorandum, p. 3).

Applicants submit that the Examiner has made a generalized statement regarding Applicants' claims 2-5, alleging that the claim elements "were well known and expected in the art at the time of the invention" without any documentary evidence to support it. See Office Action, page 4. Applicants traverse the Examiner's taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* at 1. Applicants submit that "[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common sense.'" In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the arguments presented herein, Applicants submit that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and allow

Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made" (*Id.* at 3, emphasis in original), or else withdraw the rejection. Applicants therefore request that the Examiner withdraw the rejection of claims 2-5 and allow the claims for at least the above reasons.

Claims 6 and 7, while of differing scopes, contain recitations similar to those of claim 1. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 6 and 7 under 35 U.S.C. §103(a) and allow the claims for at least the same reasons discussed above with regard to allowable claim 1.

New claims 8-10 are allowable at least due to their dependence from allowable claims 1 and 6, and include additional recitations that are neither disclosed nor suggested by the applied prior art. Applicants respectfully request that the Examiner allow new claims 8-10.

### **CONCLUSION**

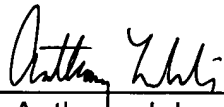
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW;  
GARRETT & DUNNER, L.L.P.

Dated: January 4, 2005

By:   
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Anthony J. Lombardi  
Reg. No. 53,232